REMARKS

Claims 1-3, 10-14, 16, 37-47, 49-51, 54, 57-58, 60-66 are pending in the present application. Claims 1-2, 10-16, 37-47, 49-50, 54, 57-58, 60-62, and 65 have been rejected under 35 U.S.C. 103(a) as being unpatentable under *Burke* in view of *Hendricks*. Claim 3 has been rejected under 35 U.S.C. 103(a) as being unpatentable under *Burke* in view of *Hendricks* in further view of *Boursier*. Claims 51 and 63-64 have been rejected under 35 U.S.C. 103(a) as being unpatentable under *Burke* in view of *Hendricks* in further view of *Sonesh*.

Claim 1 has been amended to delete an unnecessary limitation. Claim 66 has been added as a dependent claim.

In regard to the rejection of claims 1-3, 10-14, 16, 37-47, 49-51, 54, 57-58, 60-65, the Examiner has not shown that all the elements of a prima facie case of obviousness have been met. Applicants respectfully traverse the rejection and request reconsideration because the cited references do not result in claimed invention. Moreover, applicants have reviewed the cited art and have found that nothing therein would teach or suggest modifying the cited art in the manner proposed by the Examiner.

The cited combination does not result in the claimed invention because *Burke* does not teach that the video access apparatus itself is adapted to process television signals corresponding to a TV program over transmission channel 103. The Examiner relies on column 4, lines 50-67, and column 11, lines 49-67 as evidencing CATV signals corresponding to television programs.

However, Applicants respectfully assert that the video access apparatus of *Burke* is limited to processing internally only one RF channel for carrying the videophone signal. The video access apparatus of *Burke* does not process internally CATV television signals corresponding to television programs. As stated above, The Examiner relies on column 4, lines 50-67 and Column 11, lines 49-67. However, the portion of text within Column 4 merely discloses the existence of a video access device providing audio/video telephony and conferencing services over an HFC network. There is no description about the capabilities of the video access apparatus that related to processing CATV signals for television programs.

In Column 11, lines 49-67, there is also insufficient support for the Examiner to assert that the video access apparatus processes television programs. Although this paragraph infers that a movie may be received from a CATV network and watched simultaneously in a picture-in-picture format along with video images from a monitoring camera, this is still devoid of any inference to or explanation as to how the video access apparatus would process television programs.

Applicants assert that *Burke* may merely discloses ***passing through*** television programs to the televisions. Applicants note that in Figs. 2 and 3 that the video displays are separate from the phone and that in Fig. 13 that the video display and telephone are integrated. Therefore, Applicants assert that the video access apparatus of *Burke* does not teach a user interface for controlling television programs presented on the separate display devices or on the integrated videophone and display. Because there is no user interface for controlling the television programs when presented to the user, Applicants assert that the television programs merely pass through the video access device of *Burke*. Therefore, reconsideration is respectfully requested because the video access apparatus does not process both videophone signals along with the television programs as claimed in the present invention.

Applicants assert that, to the extent that *Burke* could disclose simultaneous viewing of a movie along with video from a monitoring camera in a picture-in-picture format, it is only possible to have simultaneous viewing as a result of having a second input to provide the movie or that there is a second tuner in the television or display to provide the movie. Those skilled in the art appreciate that only either of these two possibilities would be the means to provide picture-in-picture based upon the disclosure of *Burke*.

The disclosure of *Burke* does not teach the video access apparatus processing television programs internally because of what is disclosed in Fig. 4 and its associated text. In particular, Fig. 4 discloses a filter and up mixer 325 to establish a vacant channel for the videophone data. Also, in Column 12, lines 9-11, it is taught that video channels are blanked out with this filter and that this designated channel or another vacant channel is then utilized for the video conferencing. Therefore, *Burke* teaches that video access apparatus only filters in the RF channel carrying the corresponding videophone data and thus only

processes internally videophone data. To the extent that *Burke* could somehow teach that this one channel processed by the video access apparatus could provide the television program as well as the videophone data and then processes them both internally, it would not then be possible for the video access apparatus to serve multiple televisions unless all TVs were to receive and display the same television program simultaneously. Respective viewers would not have a choice to choose a different TV program from the video access apparatus. Therefore, to the extent that *Burke* discloses television programs to multiple displays, Applicants assert that the video access apparatus merely passes the television programs through and is void of any means for controlling the television programs.

Thus, Applicants respectfully assert that it can not be inferred from *Burke* that the video access apparatus processes television programs internally because the movie or video from CATV is filtered meaning that the movie was not been processed by the video access apparatus and that then the movie must have come from the video access apparatus as a result of merely being passed through the video access apparatus or is alternatively provided from another input directly attached to the TV. Moreover, Applicants assert that to the extent *Burke* discloses providing a television signal corresponding to videophone data, which Applicants assert is not processed internally in the video access apparatus, such television signal is conclusively limited to an analog television signal which is not a digitized compressed signal and therefore is outside the scope of the claims of the present invention.

Applicants' claim asserts transmission of compressed digital videophone data from the set-top terminal and videophone terminal via a second communication channel. *Burke* explicitly teaches second communication channel 227 as carrying analog video signals and not transmission of compressed digital videophone data via second communication channel 227.

The Examiner has admitted that *Burke* does not show "receiving compressed digitized TV signals" corresponding to a TV program into the video access apparatus. In order to teach this missing limitation, the Examiner uses the *Hendricks* reference to teach the compressed digitized TV signal corresponding to a TV program. However, Applicants respectfully assert that *Hendricks* also does not disclose providing television programs processed through a video access apparatus. Applicants note that

the Examiner has not relied upon *Hendricks* for disclosing this feature of the claimed invention. Therefore, reconsideration of the present claims is again respectfully requested because the cited combination does not result in the claimed invention.

Applicants also respectfully traverse the obviousness rejections based upon the cited combination of *Burke* and *Hendricks* because Applicants have reviewed the cited art and have found that nothing therein would teach or suggest modifying the cited art in the manner proposed by the Examiner. As mentioned above, the Examiner has admitted that *Burke* does not show "receiving compressed digitized TV signals" corresponding to a TV program into the video access apparatus and therefore relies upon the *Hendricks* reference to teach the compressed digitized TV signal corresponding to a TV program.

However, obviousness cannot be established to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination. The claimed invention must be considered as a whole, and there must be something in the prior art as a whole to suggest the *desirability*, and thus the obviousness, of making the combination. Applicants respectfully assert that the *Hendricks* reference does not provide any motivation to combine its teachings with those of *Burke*. In particular, there in not even a hint in either *Burke* or *Hendricks* which could reasonable suggest or allude to the desirability of utilizing videophone signals for a videophone in combination with television signals that are compressed digital signals.

Therefore, it is the duty of the Examiner to explain why this combination of references is proper. Applicants respectfully assert that, based on the manner in which the Examiner relies on *Hendricks*, which Applicants respectfully assert is improper, the Examiner could have just as well have combined *Burke* with any other reference which merely discloses compressed digitized television signals. However, Applicants note that the Examiner only cited *Hendricks* and, therefore, Applicants respectfully assert that *Hendricks* is no different from any other CATV reference that happen to reference compressed digital video which are void of motivation to be combined with *Burke*. Thus, Applicants respectfully request that the Examiner indicate where the motivation in *Hendricks* lies to support its combination with *Burke*. In particular, where in *Hendricks* is there a suggestion to utilize videophone signals for a

videophone in combination with compressed digital television signals as in the present invention? Reconsideration of the obviousness rejections based upon the combination of *Burke* and *Hendricks* is respectfully requested because *Hendricks* is non-analogous art and therefore void of any motivation to suggest its combination with *Burke*.

Therefore, Applicants find no motivation to combine the *Burke* and *Hendricks* references. They deal with problems different from the problem solved by the present invention. The *Burke* reference concerns a videophone conferencing system and solves the problem of allowing multiple, simultaneous video conferences from more than one location. The *Hendricks* reference concerns a network controller for cable television delivery systems and solves the problem of adding a network controller for a digital cable headend in a television delivery system. The present invention, on the other hand, deals with providing both videophone signals along with a plurality of television program signals in a cable television system where the subscriber requires videophone service as wells different television programs throughout the subscriber premises. Applicants assert that video conferencing from multiple locations and the addition of a network controller to a headend do not relate to the problems solved by the present invention because neither of the cited references disclose the combination of videophone data and television programs processed internally through the video access apparatus and, therefore, the cited references have a different purpose than the present invention. Therefore, Applicants request reconsideration of the obviousness rejections based upon *Hendricks* because *Hendricks* is not art analogous to the combination of videophone and television program services and, therefore, there is no motivation to combine the non-analogous teachings within *Hendricks* with the teachings of *Burke*, especially since *Burke* does not teach transmission of compressed digital videophone data over the second communication medium 227. Accordingly, Applicants respectfully request reconsideration of the obviousness rejections based upon the combination of *Burke* and *Hendricks*.

The videophone terminal in Claim 1 and its respective set of dependent Claims distinctively transport the compressed digitized videophone data between the subscriber terminal and the videophone terminal over the *second* transmission medium. The *Burke* reference does not disclose this.

In regard to claim 13, the *Burke* reference does not disclose the use of Ethernet, wireless Ethernet, firewire, or USB. (See FIG. 13 and Column 21, Lines 7-19). Also, the *Burke* reference does not teach trafficking compressed digitized videophone data in *third* communication channel 293 of FIG. 13 nor 294 of FIG. 3 and FIG. 16.

Applicants believe, therefore, that claims 1-3, 10-14, 16, 37-47, 49-51, 54, 57-58, 60-66 are in condition for allowance. Reconsideration and reexamination of the present application is requested in view of the present remarks.

CONCLUSION

The foregoing is submitted as a full and complete response to the Office Action dated June 15, 2005. Claims 1-3, 10-14, 16, 37-47, 49-51, 54, 57-58, 60-66 will be pending in the present application. Based on the remarks set forth herein, Applicants respectfully submit that the subject patent application is in condition for allowance. Because the claims may include additional elements that are not taught or suggested by the cited art, the preceding arguments in favor of patentability are advanced without prejudice to other bases of patentability.

Upon entry of the foregoing Response, the above-identified patent application includes 4 independent claims. Because Applicants have previously paid for 65 total claims and 6 independent claims, Applicants submit that no additional fee is due. Should the Examiner have any comments or suggestions that would place the subject patent application in better condition for allowance, he is respectfully requested to telephone the undersigned agent at the below-listed number.

Respectfully submitted:

SEND CORRESPONDENCE TO:

Scientific-Atlanta, Inc.
Intellectual Property Dept. MS 4.3.510
5030 Sugarloaf Parkway
Lawrenceville, GA 30044

By: _____
WM. BROOK LAFFERTY
Agent of Record
Reg. No. 39,259
Phone: (770) 236-2114
Fax No.: (770) 236-4806